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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,057

Applicant(s)

HOLLAND ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) 23-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to Applicant's communication dated July 21, 2003. Election of claims 1-4 with traverse by the Applicants is acknowledged. Also cancellation of claims 5-22 has been noted. Arguments with regards to restriction/election are addressed below. Elected claims 1- 4 have been examined. The rejections are stated below.

Response to Arguments

2. The reasons for restricting the claims into six categories have been presented in the last office action. However for the sake of clarity the following additional information is presented. Claims of group IV are drawn to an apparatus, which is clearly different from the system claims of groups V and VI and method claims of groups, I –III. The methods can be performed using a different apparatus and hence their utilities are different from that of the apparatus. Groups V and VI are system claims and deal with the configuration of the respective systems, which is clearly different in scope from the method claims of groups I –III. The methods can be performed using a different system configuration and hence their utilities are different from that of the systems in groups V and VI. Claims of group I are drawn to a method including the steps of defining which of said plurality of members are included in at least one of said communities, defining which of said plurality of traders are included in which of said plurality of members, and allowing at least one of said traders to authorize at least one of a) interaction between a first of said traders and a second of said traders, and b) interaction between a first of said members and a second of said members. There are no steps defining how the traders, members and communities are linked and allowing interaction between them based on their linking relationship. The linking relationship between the various entities and

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participants and allowing interaction between them based on their linking relationship clearly makes the scope of group I claims different from the scope of the method in group II. Method of group I is executed independently and differently from the method of group II making the utility of group I different from that of group II. These two inventions also require separate searches. Method of group III includes the steps of creating a database, restricting access of at least one of said traders to a portion of said database based on at least one of a) a first definition of a first relationship between said trader to at least one of said members, and b) a second definition of a second relationship between said trader to at least one of another of said traders. The steps of creating a database and restricting access based on a certain criterion is clearly different from the steps of defining which of said plurality of members are included in at least one of said communities, defining which of said plurality of traders are included in which of said plurality of members, and allowing at least one of said traders to authorize at least one of a) interaction between a first of said traders and a second of said traders, and b) interaction between a first of said members and a second of said members. Clearly the scope and utility of the two methods are different and they also also require separate searches. Similarly the steps in group II of defining how the traders, members and communities are linked and allowing interaction between them based on their linking relationship are clearly different from the steps in group III of creating a database and restricting access based on a certain criterion. Clearly the scope and utility of the two methods are different and they also also require separate searches.

The newly added claims 23-39 (and not 23-29 as incorrectly mentioned in the second last paragraph of remarks by the Applicants in their last communication) are

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nearly identical to the claims of groups II-VI. Applicants have elected to prosecute claims of group I with traverse. For the reasons cited in the last office action (Paper No. 8) and the additional reasons given above, the newly added claims 23-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claims in response to this office action.

Drawings

3. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al (US Patent 6,338,050 B1)

With reference to claim 1, Conklin teaches a computer implemented method for controlling a commercial environment, said environment comprising a plurality of traders, each of said traders included in at least one of a plurality of members, wherein a said plurality of members are included in at least one of a plurality of communities, said method comprising the step of defining which of said plurality of members are included

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in at least one of said communities (See Conklin Column 14 lines 14-19 and 30-33). The members are the participating companies and the traders are employees of those companies who are authorized to trade.

Conklin does not explicitly teach the steps of defining which of said plurality of traders are included in which of said plurality of members, and allowing at least one of said traders to authorize at least one of interaction between two of the traders and interaction between two of the members.

Official notice is taken that steps of defining which of said plurality of traders are included in which of said plurality of members, and allowing at least one of said traders to authorize at least one of interaction between two of the traders and interaction between two of the members are old and well known in the art. For instance in a community like a stock exchange, the members are the brokerage firms that have a seat on the exchange and the traders of the brokerage firms are the ones who execute the trade. Some brokerage firms and in turn their traders are designated as market makers in a given security. These market makers facilitate trade between two traders or between two brokerage houses in a the security for which they are market makers. These steps help in the smooth functioning of the market and also avoid interruptions.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the steps of defining which of said plurality of traders are included in which of said plurality of members, and allowing at least one of said traders to authorize at least one of interaction between two of the traders and interaction between two of the members to the invention of Conklin. The combination of the teaching taken

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as a whole suggests that the community and all its participants would have benefited from the smooth interaction of all the participants and the avoidance of interruptions.

With reference to claims 2-4, Conklin teaches a method of claim 1 as discussed above.

Conklin does not explicitly teach the steps of designating at least one of said communities in which the two traders are allowed to interact only if they both belong to the designated community; wherein ones of said members are included in more than one of said communities; and allowing said ones of said traders to authorize interaction between any of said traders and ones of said members.

Official notice is taken that the steps of designating at least one of said communities in which the two traders are allowed to interact only if they both belong to the designated community; wherein ones of said members are included in more than one of said communities; and allowing said ones of said traders to authorize interaction between any of said traders and ones of said members are old and well known in the art. Exchange rules specify that one members of the exchange may trade on the floor of exchange and hence by default the traders have to belong to the exchange. A brokerage firm can be member of more than one exchange like the NYSE, American Stock Exchange etc. A Brokerage firm may trade on its own account or on behalf of its client with another trader on the exchange. These rules allow for the orderly operation of an exchange while allowing a brokerage house to be a member in other exchanges also. By having membership on multiple exchanges the brokerage house can shop for the best deals in any given commodity or security.

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It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the steps of designating at least one of said communities in which the two traders are allowed to interact only if they both belong to the designated community; wherein ones of said members are included in more than one of said communities; and allowing said ones of said traders to authorize interaction between any of said traders and ones of said members to the invention of Conklin. The combination of the teaching taken as a whole suggests that the community and all its participants would have benefited from the orderly interaction within a community while allowing a member to shop for the best deals outside a given community and in other communities.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
August 12, 2003

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Richard Weisberger
Primary Examiner